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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,863	06/28/1999	EDWARD L. SCHLUETER JR.	D/99006	9542

7590 09/02/2004

JOHN E BECK  
XEROX CORPORATION  
XEROX SQUARE 20A  
ROCHESTER, NY 14644

EXAMINER
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HON, SOW FUN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/344,863

Applicant(s)

SCHLUETER ET AL.

Examiner

Sow-Fun Hon

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment to advisory action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 5-15 and 24-27.Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Attachment to advisory action.

***Advisory Action***

1. The request for reconsideration has been considered but does not place the application in condition for allowance for the reasons set forth below.
2. Applicant argues that the Schlueter claims do not recite the specifically recited substrate polymers of current independent claims 24, 26 and 27.

Applicant is respectfully apprised that claim 13 of Schlueter recites the polymer (fluoropolymers, chloropolymers, silicone rubbers, polyarylenes, ethylene diene propene monomer, nitrile rubbers, and mixtures thereof) (claim 13) of the “intermediate layer” on which is positioned the thiophene filled polymer coating (claim 11).

Independent claims 26, 27 of the present application recite the polymer (fluoropolymers, chloropolymers, silicone rubbers, polyarylenes, ethylene diene propene monomer, nitrile rubbers, and mixtures thereof) of the “substrate” thereon which is the thiophene coating.

Independent claims 1, 21 of Schlueter contain the term “comprising” which is open-ended and does not preclude other layers present in the fuser component. Independent claims 24, 26, 27 of the present application also contain the term “comprising” which is open-ended and does not preclude other layers present in the fuser component.

Hence the “intermediate layer” of Schlueter, on which is positioned the thiophene filled polymer coating, functions as the “substrate” which supports the thiophene filled polymer coating. Therefore, the “intermediate layer” of Schlueter, on which is positioned the thiophene coating, meets the limitation of “substrate” thereon which is the thiophene coating, in the present claims.

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3. Applicant argues that the Schlueter claims recite an outer coating which comprises a thiophene filler dispersed in a polymer, while the claims of the present application recite an “outer” coating which consists essentially of a thiophene-based material.

Applicant is respectfully apprised that when the thiophene filler is present as a major component in the coating, the limitation of “coating consisting essentially of thiophene-based material” is met.

Furthermore, Applicant is respectfully apprised that the term “outer” is not used to describe the thiophene coating as presently recited in Applicant’s claims, and is instead used to describe a separate outer coating which comprises a polymer (claim 12).

4. For the above reasons, Applicant is respectfully apprised that the rejection still stands.

5. Applicant argues that during March 2003, interviews were conducted during which the recitation of “consisting essentially of” was suggested to distinguish inter alia the reference at issue.

Applicant is respectfully reminded that a terminal disclaimer over US 6,498,918 was also suggested when the claim limitation of “consisting essentially of” was proposed by Applicant in response to the Office’s suggestion of the term “consisting of” during the interviews, and is therefore not a new issue for Applicant to consider. The term “consisting of” is consistent with Applicant’s specification (page 16, lines 5-10) which states that if the thiophene-based material is used as the surface coating, the amount of thiophene present in the layer is about 100 percent.

6. For the above reason, Applicant is respectfully apprised that finality of the Office action dated 07/14/04 still stands.

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Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571)272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*S. Hon*

Sow-Fun Hon

08/30/04

*Nasser Ahmad*  
NASSER AHMAD  
PRIMARY EXAMINER  
*Acting S/E*

8/30/04